

RESPONSE AFTER FINAL REJECTION
EXPEDITED PROCEDURE - RULE 116

Application No. 10/670,580
Attorney Docket No.: 62105.US
Client Docket No.: EI-7602

REMARKS

The amendments set out above and the following remarks are believed responsive to the points raised by the Office Action dated July 25, 2006. Reconsideration is respectfully requested.

AMENDMENTS

Claims 46-48 are added. These new claims find support throughout the specification as originally filed, for example, at page 2, line 15 to page 3, line 4 and page 15, line 6 to page 16, line 2.

REJECTIONS UNDER § 102

US 3,865,739 (Waldbillig)

Claims 11-31 and 43-44 are rejected under 35 U.S.C. 102(b) as allegedly anticipated by US 3,865,739 to Waldbillig ("Waldbillig"). Applicants respectfully disagree for at least the following reasons.

Waldbillig fails to disclose each and every limitation of pending independent claim 11 and of pending independent claim 22, and therefore fails to anticipate those claims and those claims depending therefrom. Claim 11 defines an oil soluble lubricant additive package comprising a dispersant and an extreme pressure additive, wherein the weight ratio of said dispersant to said extreme pressure additive is from about 1:7 to about 1:2 and wherein the dispersant is substantially free of boron. Claim 22 defines an oil soluble lubricant additive package comprising a dispersant and an antiwear agent, wherein the weight ratio of said dispersant to said antiwear agent is from about 10:1 to about 2:1. Waldbillig fails to disclose a lubricant additive package having such weight ratios. In particular, Waldbillig groups together certain components when defining amounts. For example, Waldbillig discloses that "detergent-dispersants" may be used in amounts between 0.5-5 wt%. Further, the "extreme pressure and antiwear agents" are likewise grouped and disclosed to be used in amounts between 0.1 and 10

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wt%. Thus one must make certain assumptions in order to determine the amount of each individual components to use. Thus, the reference is not fully anticipatory. Further, nothing in Waldbillig specifically discloses the use of a dispersant that is substantially free of boron. Further, nothing in Waldbillig specifically discloses use of a dispersant. It does disclose the use of a "detergent-dispersant", however. The presently claimed lubricant additive packages provide clean performing lubricants, and as illustrated in the present specification, lubricants which pass both the ISOT test and the L60-1 test, despite the absence of boron additives. There is simply no such disclosure in Waldbillig. Accordingly, Waldbillig fails to disclose or suggest the lubricant compositions defined in pending independent claims 11 and 22 and their dependent claims.

New claims 46-48 are likewise novel over Waldbillig. Nothing in Waldbillig discloses or suggests a method for achieving a satisfying score on the ISOT test and the L-60-1 test with a lubricating oil substantially free of boron comprising the components claimed.

US 5,922,656 (Yoshimura)

Claims 11-21, 32-41, 43 and 45 are rejected under 35 U.S.C. 102 as allegedly anticipated by US 5,922,656 to Yoshimura et al. ("Yoshimura"). Applicants respectfully disagree for at least the following reasons.

Yoshimura fails to disclose or suggest a lubricant additive package as defined in either independent claim 11 or independent claim 32. For example, claim 11 defines an oil soluble lubricant additive package comprising a dispersant and an extreme pressure additive, wherein the weight ratio of said dispersant to said extreme pressure additive is from about 1:7 to about 1:2 and wherein the dispersant is substantially free of boron. Claim 32 defines an oil soluble lubricant additive package comprising a dispersant and an antifoam agent, wherein the weight ratio of said dispersant to said antifoam agent is from about 30:1 to about 5:1 and wherein the dispersant is substantially free of boron. Yoshimura fails to disclose or suggest a lubricant additive package. In particular, nothing in Yoshimura specifically discloses targeting the defined weight ratios of components nor the specific use of a dispersant substantially free of boron. It would require undue experimentation on the part of one of skill in the art to make the claimed

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combination. Thus, Yoshimura cannot anticipate or suggest the lubricant additive packages of claims 11 and 32. Thus, it is respectfully submitted that the rejection should be withdrawn.

The presently claimed lubricant additive packages provide clean performing lubricants, and as illustrated in the present specification, lubricants which pass both the ISOT test and the L60-1 test, despite the absence of boron additives. There is simply no such disclosure in Yoshimura. Accordingly, Yoshimura fails to disclose or suggest the lubricant compositions defined in pending independent claims 11 and 32 and their dependent claims.

New claims 46-48 are likewise novel over Yoshimura. Nothing in Yoshimura discloses or suggests a method for achieving a satisfying score on the ISOT test and the L-60-1 test with a lubricating oil substantially free of boron comprising the components claimed.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

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FEEs

Please charge Deposit Account No. 12-2355 in the amount of \$400 for the payment of two new independent claims. Further, if these calculations are incorrect, the Commissioner is hereby authorized to charge any deficiencies in fees or credit any overpayment associated with this communication to Deposit Account No. 12-2355. Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 12-2355.

Respectfully submitted,


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